

No. 21105

In the

**United States Court of Appeals
For the Ninth Circuit**

RPTZ-PATCO, INC.,
*Appellant and
Cross-Appellee,*

v.

PACIFIC INLAND NAVIGATION COMPANY, INC.,
*Appellee and
Cross-Appellant.*

BRIEF ON CROSS-APPEAL

Appeal from the United States District Court
for the District of Oregon

HON. JOHN F. KILKENNY, Judge

JOHN GORDON GEARIN
8th Floor, Pacific Building
Portland, Oregon 97204

W. MELVILLE VAN SCIVER
2300 Board of Trade Building
Chicago, Illinois 60604
*Attorneys for Appellee and
Cross-Appellant*

BRIEF ON CROSS-APPEAL

STATEMENT OF JURISDICTION

This is an appeal from so much of the decree entered in the United States District Court for the District of Oregon on April 19, 1966, as holds (Pretrial Order, paragraph VI, subparagraph 3), that if claims 1, 6, 8 and 11 of the Pickrell patent in suit No. 3,033,150 are subsequently declared valid, the accused barges of the defendant infringed said claims and that such infringement was knowingly, wilfully and wantonly committed.

The jurisdiction of the District Court was admitted by the parties in the Pretrial Order, Section III, Paragraph I (C.T. 98) and was conferred upon the Court by 35 USC § 281 and 28 USC § 1338(a). A timely notice of cross-appeal having been filed (C.T. 142), this Court has jurisdiction of the cross-appeal by virtue of 28 USC §§ 1291 and 1294.

STATEMENT OF THE CASE

RPTZ-PATCO, Inc., hereinafter referred to as PATCO, as owner of Pickrell patent No. 3,033,150, filed a suit against Pacific Inland Navigation Company, hereinafter referred to as Pacific, for alleged infringement of the patent, seeking an adjudication of the validity of the patent, an injunction against further infringement, damages and attorney's fees. PATCO designated

claims 1, 6, 8 and 11 as those which were to be relied upon in the District Court to support its contentions.

A pretrial order which superseded the pleadings was agreed upon by the parties and approved by the Court (C.T. 97).

By said pretrial order, the following issues of fact (among others) were submitted to the Court:

1) Is the Pickrell patent valid?

2) If the Pickrell patent is valid, has defendant infringed it? (C.T. 108)

The Court's opinion on March 31, 1966 (C.T. 118) stated that the agreed facts and the opinion would serve as the Court's findings (C.T. 132). The Court specifically held that the patent was invalid but further found that in the event the patent were subsequently declared valid, Pacific's barges infringed claims 1, 6, 8 and 11 of the patent in suit and that the acts of infringement were knowingly, wilfully and wantonly committed (C.T. 132).

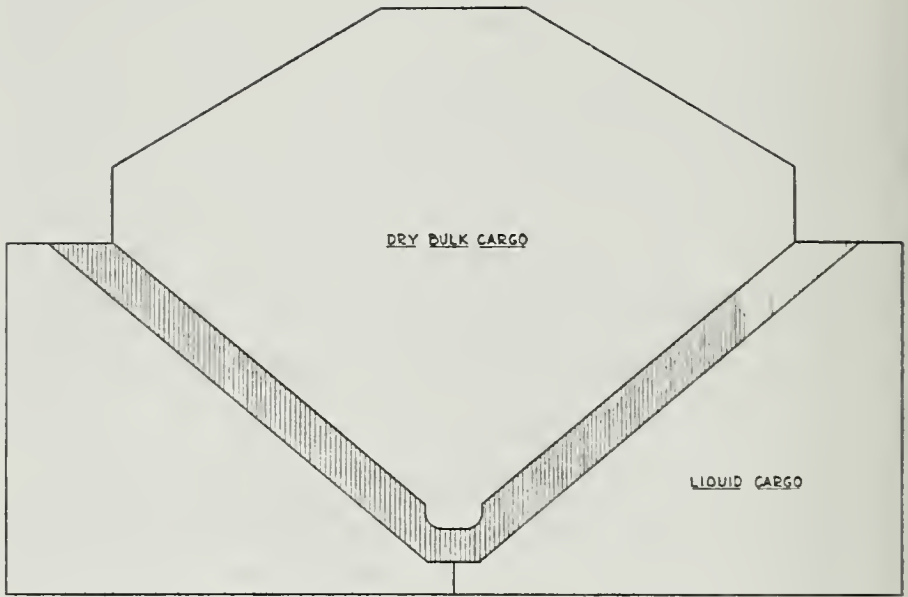
Thereafter a decree of dismissal was filed on April 19, 1966 (C.T. 134).

Thereafter and on May 18, 1966, Pacific filed its notice of appeal from the trial court's ruling of infringement (C.T. 142).

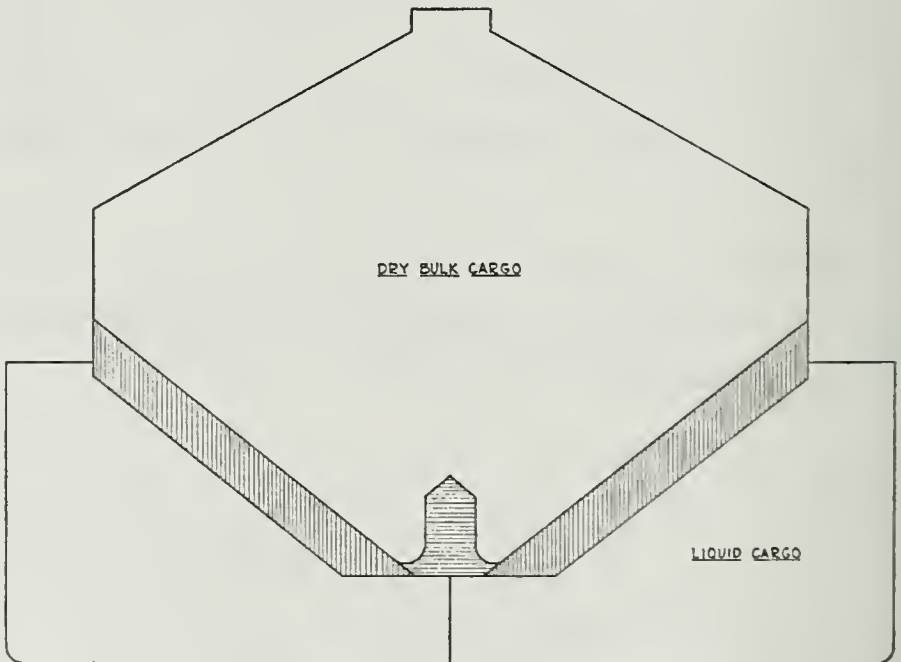
The historical and factual background of this litigation is contained in appellee's statement of the case in its answering brief, *supra*, pages 1-9, and is incorporated herein by reference.

The construction of Pacific's barges is disclosed in the enlarged reproduction of its drawing (PX 9 A-D) demonstrating that Pacific's barges have four separate cofferdams therein which are not continuous and which are not V-shaped but which are W-shaped (R.T. 357-8). There are two sloping cofferdams extending from adjacent to the deck line to near the bottom of the barge. There is a third centerline cofferdam extending the length of the barge which is connected to but not continuous with the two sloping cofferdams (R.T. 361). There is a fourth cofferdam around the grain pit which is not connected to the three other cofferdams (R.T. 358).

Pacific's resultant construction resulted in a W-shaped discontinuous cofferdam. See reproduction of DX 75 on the following page.



PICKRELL PATENT



PACIFIC INLAND BARGE

Claim 1 of the patent reads as follows:

“1. A cargo vessel for handling multiple types of cargo comprising a hull having a deck line, sides and a bottom, and an elongated cofferdam structure of substantially greater width than thickness mounted within the hull and arranged longitudinally therein, said cofferdam structure extending substantially continuously between the sides of the hull and having lateral portions that start at the sides and approximately the deck line of the hull and that slope from both sides of the hull downwardly and inwardly, said lateral portions joining at approximately the longitudinal centerline of the hull thereby to define for the cofferdam structure a substantially V-shaped cross-sectional outline, said cofferdam structure having a bottom surfacing which, together with the sides and bottom of the hull, defines cargo space adapted to carry liquid cargo, said cofferdam structure having a top surfacing defining the bottom of a self-clearing cargo space for dry cargo of substantially triangular cross section, the top and bottom surfacing being separated by a void within the cofferdam structure, said lateral portions of said cofferdam structure having means at approximately the deck line of the hull providing for entry into said cofferdam structure.”

It is noted that claim 1 calls for “an elongated cofferdam structure” which defines a single cofferdam and not a plurality of cofferdams, as in Pacific’s barges.

The claim also states that the lateral cofferdam portions slope from both sides of the hull downwardly and inwardly and are joined at approximately the longitudinal centerline of the hull to define a substantially

V-shaped cross-sectional outline. In Pacific's barges the lateral portions are not joined and are not joined at the longitudinal centerline of the hull. Furthermore, in Pacific's barges the cofferdams do not define a substantially V-shaped cross-sectional outline but define a W-shaped cross-sectional outline.

Claim 6 is the same as claim 1 with the addition of the grain collection pit.

Claim 8 is substantially the same as claim 1 except it does not state that the two sides are joined, but since it is limited to a single cofferdam structure of V-shape the two sides would have to be joined to correspond to this language.

Claim 11 is quite similar to claim 8.

With respect to file wrapper estoppel Mr. Newitt pointed out (R.T. 449-51) that Pickrell cancelled original claims 1 and 2 after rejection by the patent office, claim 2 being cancelled after the first office action (R.T. 450-1) and claim 1 being cancelled after amendment due to rejection in the first office action after the second office action (R.T. 449-51).

Original claim 1 reads as follows:

"1. A cargo vessel comprising a hull having sides and a bottom, and means within the interior of the hull defining an elongated cargo space for dry cargo, the latter means comprising a cofferdam structure

having opposed side portions, one on each side of the hull, each side portion extending downwardly into the hull and sloping inwardly from the side of the hull, said cofferdam structure having a continuous top surfacing defining the bottom of the cargo space for dry cargo and a continuous bottom surfacing which, together with the bottom and sides of the hull, defines a second cargo space adapted to carry liquid cargo, said top and bottom surfacing being separated by a void.” (DX 29)

Mr. Newitt also pointed out that statements were made on behalf of the patentee by his attorney that the interior of the cofferdam is substantially completely accessible by a workman and that with a horizontal cofferdam this would not be possible (R.T. 453). Mr. Newitt testified at R.T. 453-456 as follows:

“At this point I would like to point out that Claim 1 was still in the case; in other words, all of the claims that were being discussed here were not limited to the V-shaped cofferdam in which the legs of the V are joined together.

Now, after the Examiner rejected his Claim 1 as amended — and this was done on Page 51, your Honor — the Examiner says:

‘Claims 1 and 3 are rejected as being unpatentable over any one of Wolvin, Fletcher, Odenbach, or Maier, each in view of Henry.’

He said:

‘Each of the basic references discloses a ship with a cargo hold having inclined walls and spaces at the sides of the ship which can contain liquids. Henry discloses cofferdam structure 30

between holds in a ship as well as double wall hull construction. To make the inclined walls of the basic references of a cofferdam construction to afford access to the interior of the walls is deemed a non-inventive mechanical expedient in view of the teachings of Henry, since it is not apparent that any new or unobvious results would be obtained thereby.'

And then in response to that rejection the applicant argued, quite vigorously, with respect to the accessibility of this void space, and points out how important it is to be able to view the interior of this cofferdam from either side.

I call your attention to Page 58:

'There is the further consideration that not only has applicant conceived of cofferdam structure with a concave side defining a cargo space and a convex side defining the upper limits of a space below it, but further, and very important, applicant has conceived of such a concave cofferdam structure where at any given time by inspection along the sides of the structure the interior of the cofferdam throughout may be completely inspected even though such cofferdam in effect extends under the cargo as well as along its sides.'

And this portion beginning at 'where at any given time by inspection along the sides' has been underlined by the attorney who wrote this.

Then at Line 16:

'Added to the fact that a concave cofferdam is contemplated, therefore, is the conception of a shape which enables visual inspection of the entire interior without having to go down inside the cofferdam, even though such cofferdam has the concavity or convexity desired.'

Then he says:

'The ideas discussed above, do, in applican't [sic] opinion, bring about a new, unexpected and different type of result. The interior of the cofferdam is always easily inspected, even though the cofferdam extends under as well as down the sides of the dry cargo space which extends uninterruptedly down the length of the vessel. In this connection, merely showing V-shaped walls in a hold is not considered pertinent, since such V-shape has not been selected with any view towards providing visibility, which is a basic concept of the present invention.'

There are many, many remarks of this kind in the file wrapper. I will just point to one more.

The last word on the bottom of that Page 58:

'... but where at the same time there is visibility of bottom interior portions of the cofferdam by visual inspection from its sides.' "

One of the features of the Pickrell construction which was stressed by Pickrell was that one could gas-free the cofferdam of the Pickrell patent by placing a suction on one side thereof (R.T. 61-2).

SPECIFICATIONS OF ERROR

I

The District Court erred in finding that Pacific's barges infringed claims 1, 6, 8 and 11 of the Pickrell patent No. 3,033,150 because (a) the accused barges differ structurally and functionally from the claim in

issue, and (b) there was no infringement by the accused barges because of the defense of file wrapper estoppel.

II

The District Court erred in finding that the acts of infringement were knowingly, wilfully and wantonly committed.

SUMMARY OF ARGUMENT

A) Non-infringement

The accused barges differ structurally and functionally from the claims in issue. The patent specifications and drawings call for a continuous V-shaped cofferdam—the accused barges have not one but four which are not V but W-shaped; a system for visibility and accessibility of the entire cofferdam structure, and gas-freeing ability of the entire space, none of which are possible in the accused barges.

B) File Wrapper Estoppel

Broader claims were conceived by the inventor and the patent, therefore, cannot now be broadened to cover that which was abandoned.

C) Wilful Infringement

There could be no evidence of oppressive or fraudulent conduct when experienced Naval architects ex-

pressed surprise that the Pickrell device was patentable, particularly in view of its obviousness.

ARGUMENT

A) Non-infringement

Even without relying upon the clear file wrapper estoppel present in this case, the claims in issue are not infringed when read in the light of the specifications and drawings of the Pickrell patent.

DX 75 illustrates in simplified form the cross-section of a barge in accordance with the subject patent and the cross-section of the accused barges and demonstrates non-infringement. As pointed out in the statement of the case and as illustrated in simplified form in the drawing DX 75, Pacific's barges have four separate cofferdams which are not continuous and which are not V-shaped but which are W-shaped (R.T. 357-8), no different than the 1957 proposal to the Coast Guard. The resultant construction results in a discontinuous cofferdam.

The Pickrell patent specification states that an automatic loading system may be employed but has no other reference to this feature except that the cargo bin is self-clearing (R.T. 458). The patent is silent with respect to allegations made at the trial by PATCO's witnesses that the additional cofferdam plate adds strength

to the vessel (R.T. 457-8), and Pacific's expert, Spaulding, testified that it would add very little strength to the construction (R.T. 335). The Pickrell patent at column 4, lines 70-75, stresses that the void between the wall structure 140 and the inner walls of the pit 130 connects with the voids of the portions of the V-shaped cofferdam directly adjacent thereto which enables visual inspection of the interior of the void surrounding the grain pit from points within the cofferdam. This is impossible in Pacific's barges (R.T. 360).

Great stress is laid in the Pickrell patent as to accessibility of the entire interior of the cofferdam completely to the bottom of the vessel. This is not possible or true of Pacific's accused barges since accessibility to each cofferdam is separate and it is impossible to either see from one cofferdam to another or to gain access from one cofferdam to another (R.T. 358-60).

Another point stressed at the trial by PATCO's witnesses was that it would be possible to gas-free the entire space of the cofferdam by placing a suction device on one side of the vessel only (R.T. 61). Pacific's experts testified that this could not be done in Pacific's accused barges since the four cofferdams are completely sealed off from each other and provision must be made and is made to gas-free each of them separately. (R.T. 358).

Claim 1 has been reproduced in the statement of the

case, and it is noted that the claim includes the limitations that the cofferdam structure is of substantially V-shaped cross-sectional outline and also is limited to a single cofferdam structure extending substantially continuously between the sides of the hull. As pointed out above, the Pacific barges do not have a V-shaped cofferdam but rather have a W-shaped cofferdam and do not have a single continuous cofferdam extending from one side of the vessel completely to the other side across the bottom as shown in DX 75 in the sketch entitled "Pickrell patent."

A structural element of a claim or its substantial equivalent must be found in the accused device in order to establish infringement, and the fact that the accused device performs the same function and achieves the same result as the patented device does not in and of itself establish infringement. *Lockwood v. Langendorf United Bakeries, Inc.*, (CA 9 1963) 324 F2d 82. The fact that two devices accomplish the same result or perform the same function settles nothing about infringement. *Air Device v. Air Factors*, (CA 9 1954) 210 F2d 481. Pacific's barges accused to infringe omit elements claimed in claim 1, and no equivalent structures are present therein. In such a case, unless the element recited in the claim is present or its equivalent is found, there is no infringement. *Simons v. Davidson Brick Co.*, (CCA 9 1939) 106 F2d 518.

Claim 6 is the same as claim 1 without addition of a grain collection pit recited therein and, therefore, is not infringed by Pacific's barges (R.T. 461).

Claim 8 is substantially the same as claim 1 except that it does not state that the two sides are joined but is limited to a single cofferdam structure of V shape so that the two sides would necessarily have to be joined without interruption to correspond to this language. Since Pacific's barges are not so joined and do not divide a V shape, this claim is not infringed (R.T. 461-2).

Claim 11 is quite similar to claim 8 and does not infringe for the same reasons as set forth with respect to claims 1 and 8 (R.T. 463-4).

Summarizing, it is apparent that none of the claims alleged to be infringed by Pacific's barges are in fact infringed. The law on this subject is succinctly stated in *Pratt and Whitney Company v. United States*, (Ct Cl 1965) 345 F2d 838:

“* * * Courts have long held that a claim is not ‘like a nose of wax, which may be turned and twisted in any direction’ to make it include something not expressly recited. [citing cases] * * *” (345 F2d at 846-7)

The District Court has found that everything contained in the claims of the Pickrell patent was old except

the shape of the cofferdam, and under these circumstances it is obvious that Pickrell cannot be classified as a "pioneer patent." It is merely a very slight improvement patent in a crowded field, as shown by both the prior patents and by the barge constructions.

B) File Wrapper Estoppel

The doctrine of file wrapper estoppel may be divided into two categories: (1) the estoppel is based upon the cancellation of broader claims in response to a rejection by the patent office, or (2) the reasons given for the allowance of claims by the applicant or his attorney may cause the claims to be limited to these features.

With respect to the first category, the rule is stated in *I. T. S. Rubber Co. v. Essex Rubber Co.*, (1926) 272 US 429, 47 S Ct 136, 71 L Ed 335:

"It is well settled that where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent. * * *" (272 US at 443)

See also *Oregon Saw Chain Corp. v. McCulloch Motors Corp.*, (CA 9 1963) 323 F2d 758.

It will be apparent from a mere reading of claims 1 and 2 as originally presented that they are not limited to V-shaped cofferdam structure and are not limited to cofferdam structure which is joined adjacent the bottom centerline of the hull. Therefore, when these claims were cancelled, the subject matter thereof which would have read on Pacific's accused barges cannot now be recaptured, and the claims alleged to infringe which have these limitations referred to therein cannot be broadened to cover that which was abandoned. Therefore, since the remaining claims alleged to be infringed are necessarily limited there is no infringement by Pacific's barges.

With respect to the second category of file wrapper estoppel, the theory is that the actions taken by applicant or his attorney and the remarks made to overcome rejections by the patent office are part of the negotiations for the contract which becomes effective between the patentee and the public when the patent issues. This category of file wrapper estoppel is referred to in *Moon v. Cabot Shops, Inc.*, (CA 9 1959) 270 F2d 539.

“* * * Claims of a patent must be construed not only in the light of the specifications and drawings but also with reference to the file wrapper history. * * *” (270 F2d at 543)

Mr. Newitt testified (R.T. 452-6) as to the many points which were stressed in the arguments in the file wrapper on behalf of Pickrell. He pointed out the great stress which was laid upon the ability in the Pickrell construction to visually inspect all portions of the cofferdam from either side, including the bottom, both in the arguments and in the specification of Pickrell (R.T. 454-6). This feature is not found in Pacific's accused barges.

Mr. Newitt also pointed out that statements were made on behalf of the patentee by his attorney that the interior of the cofferdam is substantially completely accessible by a workman and that with a horizontal cofferdam this would not be possible (R.T. 453). This is also not possible in Pacific's accused barges. Mr. Newitt testified (R.T. 453-6) as follows:

“At this point I would like to point out that Claim 1 was still in the case; in other words, all of the claims that were being discussed here were not limited to the V-shaped cofferdam in which the legs of the V are joined together.

Now, after the Examiner rejected his Claim 1 as amended—and this was done on Page 51, your Honor—the Examiner says:

‘Claims 1 and 3 are rejected as being unpatentable over any one of Wolvin, Fletcher, Odenbach, or Maier, each in view of Henry.’

He said:

‘Each of the basic references discloses a ship with a cargo hold having inclined walls and spaces at the sides of the ship which can contain liquids. Henry discloses cofferdam structure 30 between holds in a ship as well as double wall hull construction. To make the inclined walls of the basic references of a cofferdam construction to afford access to the interior of the walls is deemed a non-inventive mechanical expedient in view of the teachings of Henry, since it is not apparent that any new or unobvious results would be obtained thereby.’

And then in response to that rejection the applicant argued, quite vigorously, with respect to the accessibility of this void space, and points out how important it is to be able to view the interior of this cofferdam from either side.

I call your attention to Page 58:

‘There is the further consideration that not only has applicant conceived of cofferdam structure with a concave side defining a cargo space and a convex side defining the upper limits of a space below it, but further, and very important, applicant has conceived of such a concave cofferdam structure where at any given time by inspection along the sides of the structure the interior of the cofferdam throughout may be completely inspected even though such cofferdam in effect extends under the cargo as well as along its sides.’

And this portion beginning at ‘where at any given time by inspection along the sides’ has been underlined by the attorney who wrote this.

Then at Line 16:

‘Added to the fact that a concave cofferdam is contemplated, therefore, is the conception of a shape which enables visual inspection of the

entire interior without having to go down inside the cofferdam, even though such cofferdam has the concavity or convexity desired.'

Then he says:

'The ideas discussed above do, in application [sic] opinion, bring about a new, unexpected and different type of result. The interior of the cofferdam is always easily inspected, even though the cofferdam extends under as well as down the sides of the dry cargo space which extends uninterruptedly down the length of the vessel. In this connection, merely showing V-shaped walls in a hold is not considered pertinent, since such V-shape has not been selected with any view towards providing visibility, which is a basic concept of the present invention.'

There are many, many remarks of this kind in the file wrapper. I will just point to one more.

The last word on the bottom of that Page 58: '... but where at the same time there is visibility of bottom interior portions of the cofferdam by visual inspection from its sides.'

That, your Honor, is what I depend upon when I say that the void within the cofferdam must be continuous and uninterrupted so as to provide this visibility and accessibility about which so much is made in this argument."

One of the features of the Pickrell construction which was stressed by Pickrell was that you could gas-free the cofferdam of the Pickrell patent by placing a suction on one side thereof (R.T. 61-2). This is impos-

sible in the multiple cofferdam structure of Pacific's accused barges.

Therefore, based on the second category of file wrapper estoppel, the claims of the Pickrell patent in issue are not infringed by Pacific's accused barges.

One who has abandoned and withdrawn another application as a condition of getting a patent in suit is estopped from contending from any construction of claims which would in effect secure the matters abandoned. *Bacon American Corp. v. Super Mold Corp. of Cal.*, (DC ND Cal 1964) 229 F Supp 998. The abandonment of a claim has the same legal effect as abandoning an "application."

The District Court ignored the defense of file wrapper estoppel and ignored the uncontroverted testimony regarding this defense.

C) Wilful Infringement

The issue date of the Pickrell patent was May 8, 1962. Larry Glosten, a Naval architect, received instructions from Pacific to design barges for use on the Columbia River to carry grain and petroleum. This assignment was early in 1962 (R.T. 255). The detailed drawings which Mr. Glosten prepared are dated as early as May 25, 1962, only 17 days after the issuance of the Pickrell patent. These drawings are DX 98 et seq. (R.T. 225). On their face it is apparent that it would have been impos-

sible for a Naval architect to have determined the design and construction which the barges were to have and to complete such an elaborate drawing as drawing 6207-1 (PX 9-A) in 17 days. There is nothing in the record to show that Mr. Glosten or Pacific knew of the pendency of the Pickrell patent at any time prior to its date of issue, and the evidence in the record shows that the first time that Pacific was aware of the Pickrell patent was when it received notice of claimed infringement thereof following receipt of the March 15, 1963 letter to it from PATCO's then attorneys (PX 2).

That Mr. Glosten, an independent Naval architect who maintained his own office and was not an employee of Pacific, had occasion to view the barges which turned out to be the subject matter of the Pickrell patent or had occasion to view but not copy the plans therefor cannot constitute evidence that Pacific was guilty of knowingly, wilfully or wantonly committing any acts of infringement. The record is barren of any evidence even suggesting infringement of this nature.

We have previously called the Court's attention to the testimony of Mr. Jess Carson, Naval architect, that the cofferdam in question was not a patentable article, the like testimony of Mr. Spaulding who expressed surprise that a patent was issued, and the testimony of Mr. Newitt, giving his opinion of invalidity.

“* * * Patentees generally entertain suspicion that those who challenge their claims are deliberate malefactors. However bona fide, such suspicions produce no legal effect, unless sustained by evidence substantiating suspicion as truth.” *Enterprise Mfg. Co. v. Shakespeare Co.*, (CA 6 1944) 141 F2d 916 at 920-1.)

There can be no wilful, malicious or deliberate infringement if there is a mistake as to the reasonably debatable question of validity.

The sincere genuine doubts as to the validity of the patent have been corroborated by the inventor for he testified (indicating his lack of confidence in the validity of the patent):

“Q And your deal with Lew Russell is that after you find out if the patent is any good then you will work out a royalty?

A That is correct.” (R.T. 91-2)

Moreover, the District Court found that the patent was invalid. This finding by the District Court demonstrates that any questioning by Pacific of the validity of the patent was not specious. There was no evidence of a wilful infringement or concealment—Pacific acted in good faith. See *Technograph Printed Circuits, Ltd. v. Bendix Aviation Corp.*, (DC Md 1963) 218 F Supp 1.

The prior art, the Coast Guard regulations and the earlier barges furnish a reasonable basis for a good faith belief that Pacific was entitled to build its presently accused structures without fear of infringing any valid patent which might issue. Moreover competent Naval architects expressed surprise that the Pickrell device was patentable.

The test is whether there has been oppressive or fraudulent conduct. *Laskowitz v. Marie Designer, Inc.*, (DC SD Cal 1954) 119 F Supp 541. It would seem incongruous indeed for Pacific's construction to be labeled wilful, malicious and deliberate when it proceeded in good faith to build the barge when the District Court found that there was no invention to infringe. There can be no infringement of an invalid patent, and this Court has so stated on many occasions.

CONCLUSION

The evidence fails to disclose any infringement, much less infringement of a wilful or malicious intent.

Respectfully submitted,

JOHN GORDON GEARIN

W. MELVILLE VAN SCIVER

*Attorneys for Appellee and
Cross-Appellant*

CERTIFICATE

I certify that, in connection with the preparation of the foregoing brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

Attorney

APPENDIX A

CHALLENGED FINDINGS OF THE DISTRICT COURT

1. “ ‘the subject matter of Pickrell and the prior art, including the Coast Guard Regulations was such that the subject matter as a whole would have been obvious at the time the invention [sic. “was made”] to a person having ordinary skill in the art to which said subject matter pertained.’ (C.T. 123)”

2. “The ‘Pickrell device, when viewed in the light of the decision in *Cuno*, and the provisions of 35 U.S.C. §103, as interpreted in *Graham v. Deere Co.*, supra, does not, in the last analysis, portray anything beyond the work of one merely skilled in his calling.’ (C.T. 127)”

3. “ ‘The creation of such a V-shaped design would not require more ingenuity than that possessed of a mechanic skilled in the art.’ (C.T. 130-131)”

4. “ ‘the Russell Barges and the Russell patent made obvious every feature of his design, with the exception of the cofferdam.’ (C.T. 132)”

5. “Surely, if the Pickrell device of a V-shaped cofferdam involved unique or unusual problems of engineering or construction, which were solved only by the Pickrell technique, experts would have been called to so testify. Not only, is the record completely silent on such

a claim, but the plaintiff's witnesses practically conceded that there was nothing unusual or unique in the problems of engineering or construction presented by the Pickrell device." (C.T. 127-128)

6. "the overwhelming weight of expert testimony is that it would have been a fairly simple matter to modify the earlier devices or to combine features well known in the industry and long in use, and come up with a device following the Pickrell design (C.T. 128)"

7. "the overwhelming weight of credible evidence is to the effect that there was nothing unique, novel or extraordinary in the design of a V-shaped cofferdam and that the Court could well take judicial notice that such was the fact (C.T. 130)"

8. "... on the entire record that the Pickrell device presented nothing that was not obvious in an architectural sense, nor did it demand new techniques of construction." (C.T. 131)."

9. "On this record, the Pickrell cofferdam has not been independently nor directly, demonstrated. What could make the cofferdam more obvious than a law which required its construction? The Coast Guard Regulations have the force and effect of law." (C.T. 128)

10. "the controlling reason for the inclusion of the V-shaped cofferdam in the Pickrell design was Coast Guard Regulations 32.60-10' (C.T. 130)"

11. “although the cofferdam was without precedent in the industry, the cofferdam’s form and location were, in view of prior developments in the industry, all but spelled out for Pickrell by the Coast Guard Regulations (C.T. 131).”

12. “To overcome the effect of this regulation, the plaintiff cites *Twentier’s Research, Inc. v. Hollister, Inc.*, supra, and argues that the regulations created the problem, but did not provide the solution. Plaintiff’s argument might have merit if there was evidence or logic in its support. The overwhelming weight of the credible evidence is to the effect that there was nothing unique, novel, or extraordinary in the design of a V-shaped cofferdam. For that matter, the court could well take judicial notice of that fact. Certainly, the creation of such a V-shaped design would not require more ingenuity than that possessed of a mechanic skilled in the art.” (C.T. 130-131)

13. “‘Admiral Murphy’s testimony indicates that someone brought a device similar to the Pickrell patent to the Coast Guard’s attention in 1957, long prior to the Pickrell invention.’ (C.T. 131)”.

14. “‘there was nothing in the actions of the Coast Guard at the time of the review of this design that is in any way helpful to the plaintiff.’ (C.T. 131).”

15. “‘Although, as previously mentioned, the prior

art not considered by the Patent Office would have added nothing material to that which was considered, each article of that art, would have added something to the evidence in this proceeding that the Pickrell design was obvious.' (C.T. 131)."

16. On the issues of fact outlined in the pretrial order, the Pickrell patent is invalid for the reasons here mentioned.

17. The agreed facts and opinion shall serve as the Court's findings.

APPENDIX B

DEFENDANT'S EXHIBITS

EX NO	IDENTIFIED	OFFERED	RECEIVED	REJECTED
		(Nos. Refer to R.T.)	(Nos. Refer to R.T.)	(Nos. Refer to R.T.)
DX 2	R.T. 417	417	418	
DX 9	R.T. 417	417	417	
DX 14	R.T. 418	418	418	
DX 23	R.T. 417	417	417	
DX 29	R.T. 445	445	445	
DX 37-2	R.T. 182-183	183, 430	183, 430	
DX 37-3	R.T. 350	417, 430	417, 430	
DX 37-4	R.T. 350	417, 430	417, 430	
DX 51	R.T. 284	292	Not clear	
DX 51-A	R.T. 327	326	327	
DX 51-B	R.T. 327	326	327	
DX 51-C	R.T. 327	326	327	
DX 51-D	R.T. 327	326	327	
DX 51-2	R.T. 312	313	313	
DX 53-1	R.T. 416	416	416	
DX 58	R.T. 417	417	417	
DX 66	R.T. 497	497	497-498	
DX 67	R.T. 497	497	497-498	
DX 75	R.T. 278	279	279	
DX 76	R.T. 294	Not clear	Not clear	

PLAINTIFF'S EXHIBITS

PX 1	R.T. 194	194	194	
------	----------	-----	-----	--

PX 2	R.T. 194	194	194
PX 6	R.T. 194	194	194
PX 9-A	R.T. 206	225	225
PX 9-B	R.T. 206	225	225
PX 9-C	R.T. 206	225	225
PX 9-D	R.T. 206	276	276
PX 25	R.T. 316	316	317